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No. _____

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1989

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LORNA L. NELSON,

Petitioner,

v.

PRN PRODUCTIONS, INC., ET AL.,

Respondents.

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PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

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69 pp

## QUESTIONS PRESENTED

Section 106(3) of the 1976 Copyright Revision Act, Title 17, provides a copyright owner of an unpublished copyrighted work with the exclusive right of first publication. This exclusive right of first publication is limited by the fair use provisions of Section 107, as well as other provisions (Sections 108 - 117) of the Copyright Act. The Eighth Circuit Court of Appeals, in affirming the dismissal of petitioner's copyright infringement claim for lack of substantial similarity of the accused work with respect to petitioner's unpublished copyrighted work, refused to recognize and, therefore, rejected the existence of petitioner's right of first publication.

The questions presented are:

(1) Whether copyright infringement of an unpublished work requires a determination of whether the copyright owner's right of first publication has been violated, and

(2) If so, whether an infringing violation of the owner's right of first publication (of an unpublished work) must be determined under the fair use provisions of Section 107 of the 1976 Copyright Revision Act?

## LIST OF THE PARTIES

The parties to the proceedings below were petitioner, Lorna L. Nelson, and the respondents, Prince Rogers Nelson and PRN Productions, Inc. Duane Nelson and John L. Nelson were named as parties in the complaint, but were dismissed prior to the appeal to the federal court of appeals and are not named as parties herein.

The respondents before this Court include Prince Rogers Nelson and PRN Productions, Inc.[1]

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[1] PRN Productions, Inc. has no parent companies, subsidiaries, or affiliates to list, pursuant to Rule 28.1, opinions below.

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PETITION FOR A WRIT OF CERTIORARI
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The petitioner Lorna L. Nelson respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Eighth Circuit, entered in the above-entitled proceedings on May 3, 1989.

## OPINIONS BELOW

The opinion of the Court of Appeals for the Eighth Circuit is reported at 873 F.2d 1141, and is reprinted in the Appendix hereto, p. A-1, infra. The Order of the Court of Appeals for the Eighth Circuit, denying Appellant's petition for rehearing is reported at -- F.2d --, and is reprinted in the Appendix hereto, p. A-2, infra.

The Order of the United States District Court for the District of Minnesota, Fourth Division (Doty, D. J.) has not been reported. It is reprinted in the Appendix hereto, p. A-17, infra.

## JURISDICTION

Invoking federal jurisdiction under the 1976 Copyright Revision Act, Title 17, the petitioner brought this suit for copyright infringement in the Federal District Court for the District of Minnesota. On April 28, 1988, the Federal District Court granted respondents' motion to dismiss petitioner's copyright infringement claim under Rule 12(b)(6) of the Federal Rules of Civil Procedure, for failure to state a claim upon which relief can be granted. See p. A-17 infra.

On petitioner's appeal, the Eighth Circuit, on May 3, 1989, entered a judgment and an opinion affirming the District Court's order granting respondent's motion to dismiss. See p. A-2, infra. The petition for rehearing sought by petitioner

was denied on June 26, 1989. See p. A-1, infra.

The jurisdiction of this Court to review the judgment of the Eighth Circuit is invoked under 28 U.S.C. § 1254(1).

## STATUTES INVOLVED

17 U.S.C. § 106. Exclusive rights in copyrighted works

> Subject to sections 107 through 118, the owner of copyright under this title has the exclusive right to do and to authorize any of the following:
>
> . . .
>
> (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
>
> . . .

17 U.S.C. § 107. Limitations on exclusive rights: Fair use

> Notwithstanding the provisions of section 106, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any

particular case is a fair use the factors to be considered shall include --

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;

(2) the nature of the copyrighted work;

(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

(4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 501. Infringement of copyright.

(a) Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 118, or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright.

## STATEMENT OF THE CASE

Petitioner, a resident of Minneapolis, Minnesota, is the author and owner of an unpublished lyric for music entitled, "WHAT'S COOKING IN THIS BOOK". Petitioner complied with the relevant statutory registration procedure and obtained a Certificate of Copyright Registration for her unpublished work on October 20, 1986. See p. A-88, infra. There is no dispute that petitioner's copyrighted lyric is unpublished and is protected by 17 U.S.C. 106 from unauthorized reproduction.

Respondent Prince Rogers Nelson is a well-known recording artist, composer and performer of rhythm and blues music, and is the half-brother of petitioner. PRN Productions, Inc. is a corporation,

having a principal place of business at 7801 Audubon Road, Chanhassen, Minnesota 55317 and is engaged in the business of manufacturing, producing and distributing phonograph records featuring respondent Prince Nelson. PRN is the acronym of its owner, respondent Prince Rogers Nelson.

On August 12, 1987, petitioner instituted this action for copyright infringement against respondents, alleging that respondents' publication and distribution of phonograph records and tapes of the song "U GOT THE LOOK" infringed on petitioner's unpublished work "WHAT'S COOKING IN THIS BOOK". See p. A-41, infra. The complaint also contained other claims against respondents and against Duane

Nelson and John Nelson.[2] The other claims and the parties Duane Nelson and John Nelson were dismissed by stipulation of the parties and by the District Court and were not included in the appeal to the Eighth Circuit.

On November 27, 1987, respondents filed a motion to dismiss petitioner's copyright count, pursuant to Rule 12(b)(6) of the FRCP, on the grounds that it did not state a claim upon which relief could be granted because respondents' song "U GOT THE LOOK" was not substantially similar to petitioner's unpublished lyric, "WHAT'S COOKING IN THIS BOOK". In their

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[2] Petitioner has included only the copyright count of the complaint in the appendix, since this is the only count involved in the appeal to the Eighth Circuit.

motion to dismiss, respondents admitted access to petitioner's unpublished work and also admitted petitioner's ownership of her copyrighted lyric.

In an affidavit filed in response to respondents' motion to dismiss, petitioner declared that she retained her unpublished lyric, "WHAT'S COOKING IN THIS BOOK", in confidence at her residence, and was unaware that respondents had obtained access to the lyric until this unexplained access was admitted in respondents' motion to dismiss. See p. A-49, infra. Petitioner also states in her affidavit that respondents' admitted but unauthorized access occurred without petitioner's permission and, therefore, constituted a purloined taking. Petitioner's affidavit stands uncontroverted.

Petitioner also filed an affidavit, executed by petitioner's counsel, for the purpose of showing the market effect resulting from the public distribution of the accused work, "U GOT THE LOOK". This uncontroverted affidavit and attachments (charts from various issues of the music trade journal "Billboard") demonstrate the commercially successful reception and artistic recognition of the accused work, "U GOT THE LOOK", by the purchasing public and the music industry. See pp. A-57 - A-87, infra.

The following pages (labeled "12a - 12dd") contain comparison charts of petitioner's lyric, "WHAT'S COOKING IN THIS BOOK", and respondents' lyric, "U GOT THE LOOK". An examination of these comparison charts demonstrates

that respondents' lyric contains expressions in literal and paraphrased form totalling more than 20% of the protected expressions of petitioner's unpublished lyric. The charts also demonstrate that respondents' lyric, "U GOT THE LOOK", contains protected expressions from petitioner's unpublished lyric totalling more than 30% of the accused lyric.

PLAINTIFF'S COPYRIGHTED

UNPUBLISHED, CONFIDENTIAL

LYRICS

WHAT'S COOKING IN THIS BOOK

Pick Me Up

Take A Look

Now Take Another Look

Before You Close This Book,

Open It,

There's More Love In Here

Than You'll Ever Know,

So Read Me Baby,

Take It Slow.

Let's Start At The Beginning Of Us,

A Monday Morn, Dark and Dreary,

I Was Feeling Sort of Teary,

Until I Glanced Up And Saw You,

A Smile So Pretty and New Foxy

Vivacious Were You.

As I Tried To Keep My Hands In Place,
Makeup Was Rolling Down My Face.
You Put Yours In Mine
And Said It Was Only A Matter of Time.

Something Kept Saying "What Is This,
    What Is This" In Front of Me,
There Was An Intense Feeling of Love
    Flowing Through Me,
And It Could Still Be.

So If There Is Anything Left To Us,
Don't Close This Book,
Read Me Baby, Take It Slow,
There's Too Much Love In Here
    For You To Blow.

And I Guarantee You'll Never

Take Another Look

When You Realize What's Cooking

In This Book

-- Realize What's Cooking

In This Book.

DEFENDANTS' ACCUSED

LYRICS -- ACCESS (PURLOINED

TAKING) ADMITTED

U GOT THE LOOK

U GOT THE LOOK

Here We Are Folks

The Dream We All Dream Of

Boy Versus Girl In The World

Series of Love

Tell Me, Have U Got the Look?

U Walked In, I Woke Up

I've Never Seen A Pretty Girl

Look So Tough, Baby

U Got That Look

Color U Peach and Black

Color Me Takin' Aback

Crucial, I Think I Wantcha

You've Got The Hook

U GOT THE LOOK (Continued)

U Sho'Nuf Do Be Cookin' In My Book
Your Face Is Jammin'
Your Body's Heck-A-Slammin'
If Love Is Good, Let's Get 2 Rammin'
U Got The Look
U Got The Look

U Must'A Took
A Whole Hour Just 2 Make Up Your
    Face, Baby
Closin' Time, Ugly Lights, Everybody's
    Inspected,
But U Are A Natural Beauty Unaffected
Did I Say An Hour?
My Face Is Red
I Stand Corrected
You've Got The Look,
    You've Got The Look.

U GOT THE LOOK (Continued)

U Sho'Nuf Do Be Cookin' In My Book
Your Face Is Jammin'
You're Body's Heck-A-Slammin'
If Love Is Good, Let's Get 2 Rammin'
U Got The Look, U Got The Look

Well Here We Are, Ladies and
    Gentlemen
The Dream We All Dream Of
Boy Versus Girl In The World
    Series of Love
Slammin'
U Walked In
I Woke Up
I Never Seen Such A Pretty Girl
    Look So Tough, Baby
U Got That Look, Yes You Do

Color U Peach And Black

Color Me Takin' Aback, Baby

Crucial, I Think I Wantcha

The first release or public distribution of respondents' song, "U GOT THE LOOK", was contained in respondents' album entitled, "SIGN 'O' THE TIMES". See pp. A-98 - A-101, infra. Since respondent Prince Nelson is designated as the composer of all the songs contained in the album, including the accused work, "U GOT THE LOOK", petitioner sought discovery by oral deposition of respondent Prince Nelson. Specifically, petitioner sought information explaining the admitted but unauthorized access and an explanation of the source of the expressions in respondents' song, "U GOT THE LOOK", which are identical to or a closely paraphrased form of the protected expressions in petitioner's lyric, "WHAT'S COOKING IN THIS BOOK".

Despite the fact that petitioner's

copyrighted lyric was unpublished, held in confidence, (access) illegally obtained, and despite the fact that respondents' lyric contains expressions corresponding to protected expressions in petitioner's lyrics totalling more than 30% of respondents' song, "U GOT THE LOOK", petitioner was denied all discovery with respect to her copyright infringement claim. See p. A-36, infra.

The District Court, in granting respondents' motion to dismiss, refused to recognize petitioner's right of first publication conferred upon an owner of an unpublished work by 17 U.S.C. 106(3), and, instead, found that the accused work was not substantially similar to the copyrighted work, based on a pure comparison of these works. See p. A-17, infra.

In rejecting petitioner's claim that

the question of copyright infringement of an unpublished work requires a determination of whether the copyright owner's right of first publication has been violated under the fair use provisions of 17 U.S.C. 107, the District Court completely discounted the crucial relevancy and criticality of the unpublished nature of the copyrighted work, the breach of petitioner's confidentiality, and the unauthorized access by stealth. See p. A-17, infra.[3]

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[3] Although the order of the District Court merely refers to these critical facts as "the circumstances of this case" (See p. A-20, infra.), the exchange between the District Court and petitioner's counsel clearly discloses the unimportance the court attaches to the unpublished nature of the copyrighted work, the breach of petitioner's confidentiality, and the purloined taking of the copyrighted work. Petitioner has included in the appendix that portion of the hearing transcript embodying this exchange on pp. A-25 - A-35.

In due course, petitioner took an appeal to the Eighth Circuit from the order of the District Court dismissing petitioner's copyright count and the District Court's earlier order denying petitioner discovery with respect to her copyright claim. Petitioner urged the Eighth Circuit to hold that the dismissal of petitioner's copyright infringement claim constituted reversible judicial error because her copyright infringement claim had been dismissed for lack of substantial similarity based on a pure comparison of the copyrighted and accused works, rather than a determination of whether petitioner's right of first publication had been violated under the fair use provisions of 17 U.S.C. 107.

Instead of determining whether

respondents' appropriation of expressions from petitioner's unpublished lyric, "WHAT'S COOKING IN THIS BOOK", violated petitioner's right of first publication under the fair use provisions of 17 U.S.C. 107, the Eighth Circuit limited its review to a pure comparison of the accused and protected works. In affirming the District Court's decision that respondents' lyric, "U GOT THE LOOK", did not infringe petitioner's lyric for lack of similarity, the Eighth Circuit impliedly but unequivocably refused recognition of an author's right of first publication.

The final portion of the Eighth Circuit opinion is devoted to its review of whether the District Court abused its discretion by denying petitioner discovery with respect to the copyright infringement

count. In affirming the order denying this discovery as the exercise of sound discretion, the Eighth Circuit tacitly dismissed the relevance of the unpublished nature of petitioner's copyrighted work, the breach of petitioner's confidentiality, the admitted but illegal access, and the presence of expressions from petitioner's lyric totalling more than 30% of respondents' accused lyric. See p. A-15, infra. Accordingly, the Eighth Circuit affirmed the District Court's orders in all respects and dismissed petitioner's copyright infringement claim. See p. A-16, infra.

## REASONS FOR GRANTING THE WRIT

### The Eighth Circuit's refusal to recognize the right of first publication afforded a copyright owner of an unpublished work under 17 U.S.C. 106(3) conflicts with the decisions of this Court and other Circuits.

The Copyright Revision Act of 1976 (Title 17) involved a number of innovations and recognized for the first time a distinct statutory right of first publication afforded unpublished works under Clause (3) of Section 106. This right of first publication, like other rights enumerated in Section 106, is expressly made subject to the fair use provisions

of Section 107. Harper & Row v. Nation Enterprises, 471 U.S. 539, at 552 (1985). Under the 1976 Copyright Revision Act, a charge of infringement of an unpublished work compels a determination of whether a copyright owner's right of first publication has been violated subject to the fair use provisions of Section 107.

The Eighth Circuit's refusal to recognize petitioner's right of first publication in deciding the question of infringement of petitioner's unpublished lyric, "WHAT'S COOKING IN THIS BOOK", has, in effect, eviscerated this express statutory right from the Copyright Revision Act of 1976. This drastic treatment of the Copyright Act deserves this Court's attention.

This refusal to recognize the

statutory right of first publication by the Eighth Circuit in deciding the question of infringement of petitioner's unpublished work directly conflicts with this Court's decision in Harper & Row v. Nation Enterprises, 471 U.S. 539 (1985). Harper & Row held that, in appropriating protected expressions from the unpublished copyrighted work, "A TIME TO HEAL", Nation effectively arrogated to itself the right of first publication, and this violation of the right of first publication was not a fair use and, therefore, was an infringement. 471 U.S., at 549.

Like Harper & Row, this case involves a charge of copyright infringement of an unpublished work held in confidence and in which the admitted access was unauthorized. Although it was established in

Harper & Row that Nation had knowingly exploited the purloined manuscript, 471 U.S., at 563, petitioner's affidavit that respondents' admitted access to her unpublished lyric was illegal (purloined) stands unrebutted. See p. A-50, infra. While Harper & Row was decided after a full trial on the merits, in contrast to the dismissal of petitioner's copyright infringement claim on respondent's motion, this procedural difference does not appear to be significant on the issue of whether copyright infringement of an unpublished work requires a determination of whether the author's right of first publication has been violated under the fair use provisions of Section 107.

Even though the relevant and operative facts in Harper & Row and the instant

case are substantially identical, the Eighth Circuit nevertheless sought to distinguish Harper & Row from the instant case. Noting that "Nation Magazine argued that its admitted copying of a portion of the memoir constituted a 'fair use'", the Eighth Circuit observed that respondents "have not chosen to assert" fair use as a defense, but chose instead to challenge the accused infringement on the grounds of lack of substantial similarity. The Eighth Circuit then held that the issue of copyright infringement of peitioner's (unpublished) lyric could be and was properly decided on the basis of the substantial similarity test. See p. A-12, infra.

This distinction rests upon the premise that a charge of copyright infringement of an unpublished work

may be selectively challenged either under the substantial similarity test or under the fair use defense at the election of the accused infringer. By its logic, the Eighth Circuit does not observe the traditional (and statutory) distinction between fair use or infringement of published and unpublished works.

While the 1976 Copyright Act makes the right of first publication under Section 106(3) expressly subject to the fair use provisions of Section 107, this Court concluded that the Copyright Act reflects the intent of Congress to codify the common law doctrine of fair use. 471 U.S., at 549.

In recounting the evolution of the right of first publication, in Harper & Row, this Court noted that this right (of

first publication) was originally absolute under common law until he (the author) parted with the same, but this absolute rule was tempered in practice by the equitable nature of the fair use doctrine. 471 U.S., at 551. The Court added in words particularly relevant to the Eighth Circuit's refusal to recognize petitioner's right of first publication of her unpublished lyric,

> "Publication of an author's expression before he has authorized its dissemination seriously infringes the author's right to decide when and whether it will be made public, a factor not present in fair use of published works." (471 U.S., at 551).

Although Harper & Row is unequivocally clear in holding that a charge of infringement of an unpublished work compels a determination of whether the

author's right of first publication has been violated under the fair use provisions of Section 107, the Eighth Circuit's decision holds to the contrary. The Eighth Circuit decision stands for the proposition that one accused of copyright infringement of an unpublished work may vitiate the relevance of the unpublished nature of the work and avoid a consideration of the author's right of first publication by simply challenging the accused infringement with the defense of lack of substantial similarity.

Under its decision, the Eighth Circuit has tacitly concluded that the right of first publication is not a right vested in the author of an unpublished work at the time the work is created, but apparently is an illusory right, which comes

into existence if, and only if, an accused infringer asserts the fair use defense. Under the Eighth Circuit decision, a clever tactician defending against a charge of copyright infringement involving an unpublished work may effectively destroy the author's right of first publication through the agency of the election of defenses.

The totality of the conflict between Harper & Row and the instant case can be readily seen from the comparison charts on the following pages (labeled "28a - 28cc"). The comparison charts not only compare the relevant operative facts in Harper & Row with those of the instant case, but also compare Harper & Row with the instant case in an analysis under the fair use factors of Section 107.

The comparison charts clearly demonstrate the striking identity of relevant facts between Harper & Row and the instant case. While the judicial procedure followed in Harper & Row and the instant case is decidedly different, this difference merely underscores the confusion of the Eighth Circuit about an author's right of first publication and the defense of fair use as it relates to unpublished works. The completeness of the conflict between Harper & Row and the instant case is more clearly demonstrated by the comparison of Harper & Row and the instant case under the fair use factors of Section 107. A comparison of the facts for each factor will be addressed separately.

LORNA L. NELSON

v. PRN PRODUCTIONS, ET AL.

Copyrighted Work

Copyright Registration - lyric

Unpublished

Access unauthorized

Held in confidence

Access was admitted

Purloined taking - unrebutted

Court Procedures and Disposition

District Court -- Denied Petitioner discovery

-- Granted Respondent's Motion to dismiss - Lack of substantial similarity

Eighth Circuit -- Affirmed District Court

LORNA L. NELSON

v. PRN PRODUCTIONS, ET AL.

Purpose of Accused Work

Production and distribution of musical recordings for profit

Accused work - lyric with music in a record, tape, or video

Unfair use?

Nature of Copyrighted Work

Unpublished lyric for rhythm & blues music

"WHAT'S COOKING IN THIS BOOK"

(176 words)

Style - Lyrical verse

Unfair Use?

LORNA L. NELSON

v. PRN PRODUCTIONS, ET AL.

Amount of Copying

Accused work ("U GOT THE LOOK") -

-- 242 words

-- Respondents appropriated 20% of copyrighted work

-- Respondents' work - contains 30% of protected expressions

Unfair Use?

Market Effect

Accused work was highly commercially successful

Unfair Use?

## HARPER & ROW PUBLISHERS

## v. NATION ENTERPRISES

### Copyrighted Work

Copyright Registration - book

Unpublished

Access unauthorized

Held in confidence

Access was admitted

Knowing use of Purloined work

### Court Procedures and Disposition

District Court -- Found Unfair Use and Infringement

Second Circuit -- Reversed - Found Fair Use

U.S. Supreme Court -- Reversed - Found Unfair Use

HARPER & ROW PUBLISHERS

v. NATION ENTERPRISES

Purpose of Accused Work

News reporting

for profit

Accused work - newsworthy article

in The Nation magazine

Unfair Use!

Nature of Copyrighted Work

Unpublished memoirs (book) of former

President Gerald Ford

"A TIME TO HEAL"

(655 pages)

Style - Factual narrative

Unfair Use!

HARPER & ROW PUBLISHERS

v. NATION ENTERPRISES

Amount of Copying

Accused work - ("THE FORD MEMOIRS - BEHIND THE NIXON PARDON") -

-- 300 words out of 200,000

-- Nation appropriated less than 1% of copyrighted work

-- Nation article contained 13% of protected expressions

Unfair Use!

Market Effect

Clear demonstration of actual damage ($12,500) from infringement

Unfair Use!

Purpose of the Use

Harper & Row held that the purpose of Nation's use of the unpublished work was unfair because: (a) although the general purpose of this use was news reporting, Nation went beyond simply reporting uncopyrightable information and sought to exploit the headline value of its infringement by making a news event of its unauthorized first publication of the copyrighted expression, 471 U.S., at 561; (b) the use was commercial, as opposed to a non-profit use and the commercial use of copyrighted material presumptively is an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright, 471 U.S., at 562; and (c) that Nation could not offer up even the fiction of consent as

justification of its use because Nation had knowingly exploited a purloined manuscript, 471 U.S., at 563.

In the instant case, the only purpose of respondent's production and distribution of the accused work, "U GOT THE LOOK", which appropriated petitioner's protected expressions, was to generate profits. The denigration of the relevance of the impropriety of respondent's behavior in purloining petitioner's unpublished work, "WHAT'S COOKING IN THIS BOOK", tacitly affirmed by the Eighth Circuit, is best reflected in the District Court's statements:

> "I mean I don't see my role as determining whether there is thievery. . . . That it is the role of the court to now see, for the purposes of copyright infringement, as to whether there was infringement, not whether there was a purloining

of the lyrics.". See pp. A-24 - A-35, infra.

The Eighth Circuit's total disregard for respondents' crass commercialization of petitioner's protected expressions in the accused work, "U GOT THE LOOK", after respondents purloined petitioner's unpublished work, serves only to underscore the complete conflict under this fair use factor between Harper & Row and the Eighth Circuit's decision.

Nature of the Copyrighted Work

Harper & Row holds that the unpublished character of a work is a critical element of its nature, and further holds that the scope of fair use is narrower with respect to unpublished works. 471 U.S., at 564.

In concluding that Nation's use was

unfair, this Court noted:

> "While even substantial quotations might qualify as fair use in a review of published work for a news account of a speech that had been delivered to the public or disseminated to the press, (see House Report, at 65), the author's right to control the first public appearance of this expression weighs against such use of the work before its release. Right of first publication encompasses not only the choice of whether to publish at all, but also the choices of when, where, and in what form first to publish a work.". 471 U.S., at 564.

Harper & Row emphasizes the criticality of the unpublished nature of a copyrighted work and its (unpublished nature) impact on the copyright owner's right of first publication, while the Eighth Circuit decision completely disregarded the unpublished nature of petitioner's copyrighted lyric and refused

to recognize petitioner's right of first publication.

Despite the fact that the sole issue presented to the Eighth Circuit on appeal involved the issue of infringement of petitioner's unpublished lyric and petitioner's right of first publication, the Eighth Circuit failed to even mention the expressions "unpublished" and the author's "right of first publication" in its decision. The Eighth Circuit's justification for its decision rests upon the fact that respondents did not raise the defense of fair use, and, therefore (the Court apparently concluded), there was no need to consider the unpublished nature of petitioner's lyric and her right of first publication. See p. A-11, infra.

After disregarding the unpublished

nature of petitioner's copyrighted lyric and her right of first publication, the Eighth Circuit cited and relied on Hartman v. Hallmark Cards, Inc., 833 F.2d 117 (8th Cir. 1987) as controlling the question of infringement before it on appeal. However, the issue of copyright infringement in Hartman v. Hallmark Cards did not involve an accused infringement of an unpublished work or the copyright owner's right of first publication, but involved an accused infringement of a published work where the substantial similarity test was the appropriate standard to be applied.

Even though the sole substantive issue presented to the Eighth Circuit was whether respondent's appropriation of protected expressions from petitioner's

unpublished copyrighted work, "WHAT'S COOKING IN THIS BOOK", violated petitioner's right of first publication, the Eight Circuit decision totally discounted the critical relevance of the unpublished nature of petitioner's lyric and refused to recognize petitioner's right of first publication. The Eighth Circuit decision is not only logically unexplainable, but the conflict with Harper & Row could not be more complete under this fair use factor.

Amount and Substantiality
of the Portion Used

In Harper & Row, noting that Nation appropriated an insubstantial portion (substantially less than 1% of the copyrighted work as a whole), this Court concluded that Nation took essentially the

heart of the book. 471 U.S., at 565. By way of contrast, respondents have appropriated in excess of twenty percent (20%) of petitioner's unpublished lyric and have structured seven of the eight verses of the accused work, "U GOT THE LOOK", around literal or paraphrased expressions taken from petitioner's copyrighted lyric. See the comparison charts, supra, pp. 28a - 28cc.

In Harper & Row, the direct takings from the unpublished manuscript constituted at least thirteen percent (13%) of the infringing article, 471 U.S., at 505, while the protected expressions taken from petitioner's work constitute in excess of 30% of the accused work, "U GOT THE LOOK". Although the quantitative appropriation in the instant case

exceeds the quantitative taking in Harper & Row by orders of magnitude, the qualitative taking in the instant case (the structuring of seven of eight verses in the accused work with appropriated expressions) is at least as great as the qualitative taking (heart of the book) in Harper & Row.

Finally, in Harper & Row, the protected work was a factual historical narrative, while in the instant case, peitioner's unpublished copyrighted work is a lyric having a rhyme scheme, a work of fantasy. As this Court noted, in Harper & Row, "The law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy.". 471 U.S., at 539. While there is greater appropriation of

protected expressions by the accused infringer in the instant case than in Harper & Row, there is also a greater need to protect petitioner's poetic lyric than the need to protect a historical factual narrative. The Eighth Circuit decision offers no explanation or even the semblance of a justification for the unauthorized appropriation of protected expressions by respondents from petitioner's unpublished poetic lyric.

Effect on the Market

Although petitioner has been severely handicapped by the denial of discovery, the evidence of record, which was discounted by the Eighth Circuit, indirectly establishes that the market effect of the accused infringement weighs against respondents. In Harper & Row, this Court found

direct evidence of damage, resulting from the infringement. 471 U.S., at 567. In the instant case, the accused work, "U GOT THE LOOK", enjoyed substantial commercial success and was the only one of twelve (12) songs in the album, "SIGN 'O' THE TIMES" ("U GOT THE LOOK" was released in the album "SIGN 'O' THE TIMES"), which was nominated for a Grammy Award. See Bains' Affidavit and attachments, pp. A57 - A87, infra.

While the undeniable commercial and artistic success of the accused work, "U GOT THE LOOK", is only indirect evidence of the market effect of the accused infringement, this Court noted that, ". . . to negate fair use, one need only show that, if the challenged use 'should become widespread, it would adversely

affect the potential market for the copyrighted work'.", 471 U.S., at 568, citing Sony Corp. of America v. Universal Studios, Inc., 464 U.S., at 451 (emphasis added); id., at 484, and no. 36 (collecting cases) (dissenting opinion). The nationwide commercial success and the artistic recognition (Grammy Award nomination) of the accused work is a strong indication of the widespread use of petitioner's unpublished expressions by respondents, thereby adversely affecting the market potential of the protected work.

## The Conflict with the Second Circuit Decisions

Equally in conflict with the Eighth Circuit decision below is Salinger v. Random House, Inc., 811 F.2d 90 (2nd Cir.

1987) and New Era Publications Intern. v. Henry Holt & Co., 873 F.2d 576 (2nd Cir. 1989).

In Salinger v. Random House, J. D. Salinger, a well-known author, sought to enjoin publication of Salinger's biography, based on the alleged misappropriation by the accused infringers of expressions from Salinger's unpublished copyrighted letters. Salinger's charge of infringement was resisted by the accused biographers on the grounds that they had made a fair use of the unpublished letters. The Second Circuit, in finding that the use by Random House was unfair, scrupulously followed this Court's approach in Harper & Row and concluded, "We place special emphasis on the unpublished nature of Salinger's

letters and proceed to consider each of the four statutory fair use factors.". 811 F.2d, at 96.

In Salinger v. Random House, Inc., the Second Circuit construed this Court's observation (in Harper & Row) that the scope of fair use is narrower with respect to unpublished works in its conclusion:

> "However, we think that the tenor of the Court's entire discussion of unpublished works conveys the idea that such works normally enjoy complete protection against copying any protected expression. Narrower 'scope' seems to refer to the diminished likelihood that copying will be fair use when the copyrighted material is unpublished.". 811 F.2d, at 97.

The Second Circuit found that the purpose of the unpublished letters was fair, since "[T]he book may be considered "criticism', 'scholarship', and 'research'". 811 F.2d, at 96. See

17 U.S.C. Section 107. However, the Second Circuit then found that, "[S]ince the copyrighted letters are unpublished, the second factor weighs heavily in favor of Salinger.". 811 F.2d, at 97. The Second Circuit also found that the amount of substantiality of the portion used by Random House, even in paraphrased form, was unfair. 811 F.2d, at 98, 99. The proportional amount and the quality of the material appropriated in Salinger v. Random House corresponds to the quantity and quality appropriated in the instant case. Finally, the Second Circuit found that the potential effect on the market weighed in favor of Salinger. 811 F.2d, at 99.

In New Era Publications Intern. v. Henry Holt & Co., supra, the copyright

owners sought to enjoin publication of the biography of L. Ron Hubbard, founder of the Church of Scientology, based on the alleged misappropriations by the accused infringers of expressions from Hubbard's unpublished copyrighted diaries. The Second Circuit, in its fair use analysis, found that the purpose of the use by the accused biographers was fair because the book could be classified as a work of criticism, scholarship, or research. 873 F.2d, at 583.

However, the Second Circuit found the remaining fair use factors in New Era to be unfair. Specifically, the Second Circuit found "[W]here use is made of materials 'of an unpublished nature', the second fair use factor is yet to be applied in favor of an

infringer, and we do not do so here.". 873 F.2d, at 583.

The Second Circuit in New Era also found that the amount of material appropriated by the accused infringer was unfair, even though the Second Circuit characterized the amount of material used as being more than "small". 873 F.2d, at 584. The proportional amount and quality of the material appropriated from the unpublished diaries appears to be substantially less than the material appropriated in the instant case. Finally, the Second Circuit in New Era also found that there was some impairment of the market and the market effect, as it was, therefore, deemed to be unfair. 873 F.2d, at 583.

In Salinger v. Random House and in

New Era Publications Intern. v. Henry Holt & Co., the Second Circuit, in following Harper & Row, stressed the criticality of the relevance of the unpublished nature of Salinger's letters and Hubbard's diaries, the copyright owner's right to control first publication, and the requirement of the fair use defense in resisting a charge of infringement of an unpublished copyrighted work.

In the instant case, the Eighth Circuit has totally discounted the relevance of the unpublished nature of petitioner's copyrighted lyric, refused to recognize petitioner's right of first publication, and has rejected petitioner's contention that Salinger v. Random House, New Era Publications v. Henry Holt & Co., and Harper & Row v. Nation Enterprises,

require a determination of infringement under the fair use provisions of Section 107 when the copyrighted work is unpublished.

The Eighth Circuit's confusion about the right of first publication conferred upon the author of an unpublished work under the 1976 Copyright Revision Act is found in the precedents cited in the opinion below. See pp. A-7 - A-13, infra. All of those involved infringement issues of published copyrighted works or involved decisions decided under the earlier Copyright Law (preceding the 1976 Copyright Revision Act), which did not expressly recognize the right of first publication for unpublished works.

The Eighth Circuit decision is in

complete conflict with the decisions of the Second Circuit in Salinger v. Random House and New Era Publications v. Henry Holt & Co. The Eighth Circuit has, therefore, created a confusing precedent, likely to generate even further confusion among the Circuits. It is a precedent directly at odds with this Court's ruling in Harper & Row. Plenary consideration of the matter by this Court is essential.

## CONCLUSION

For these various reasons, the petition for certiorari should be granted. If petitioner is correct in urging that the Eighth Circuit should have decided that the question of infringement of petitioner's unpublished lyric, "WHAT'S COOKING IN THIS BOOK", requires a determination of whether petitioner's right of first publication had been violated under the fair use provisions of 17 U.S.C. 107, the matter should be remanded to the District Court for appropriate disposition, after a full development of the facts concerning the unauthorized use by respondents of petitioner's

protected expressions.

Respectfully submitted,

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